

REMARKS

Entry of the foregoing amendments, and reexamination and reconsideration of the subject application, pursuant to and consistent with 37 C.F.R. §1.104 and §1.112, and in light of the following remarks, are respectfully requested.

Claims 10-14 have been amended, and new claims 15-27 have been added.

Claims 10-14 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention, which rejection is respectfully traversed. Specifically, the Examiner has objected to lines 1-4 of Claim 10. Claim 10-14 are amended herein to clarify the subject matter of the invention

Claims 10-14 have been rejected under 35 U.S.C. §102(b) as being anticipated by, or in the alternative, under 35 U.S.C. §103(a) as being obvious over Goto et al., which rejection is respectfully traversed. While it is the Examiner's opinion that the claimed invention is an obvious variation, the Examiner has failed to point out the teaching in Goto, on which the claims allegedly read. Further, the Examiner has arbitrarily labeled the dependent claims as conventional without the slightest explanation of how such a conclusion was reached. The Rejection is arbitrarily dismissing claimed structural limitations without any evidence to support the rejection. The Rejection has failed to establish a prima facie case of obviousness by the failure to produce prior art. The use of a single reference to show obviousness is improper: there must be some evidence from the reference or other objective source, or evidence provided

through an affidavit from the examiner, to illuminate why the *differences* between the claimed invention and the cited art would have been obvious. *In re Laskowski*, 10 USPQ2d 1397 (Fed. Cir. 1989); *In re Grabiak*, 226 USPQ 870, 872 (Fed. Cir. 1984); 37 C.F.R. §1.104(C)(2) and §1.104(d)(2). That knowledge may have been within the province of the ordinary artisan does not in and of itself make it so, absent clear and convincing evidence of such knowledge. See *C.R. Bard, Inc. v. M3 Sys., Inc.*, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998), *cert. den.* 1998 S. Ct. 1804 (1999); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 297-98, 227 USPQ 657, 667 (Fed. Cir. 1985). The range of sources available for evidence of a suggestion, teaching, or motivation to modify a reference, whether from the prior art references themselves, one of ordinary skill, or from the nature of the problem, does not diminish the requirement for presenting actual evidence; and the actual evidence must be clear and particular. *C.R. Bard, In re Dembiczak*, 50 USPQ2D 1614, 1617 (Fed. Cir. 1999). Therefore, unless the showing on which the rejection is based is clear and particular, the suggestion to modify the reference would appear to be hindsight reconstruction based on the rejected claim. *W.L. Gore and Assoc., Inc. v. Garlock, Inc.*, 220 USPQ 303, 312-13 (Fed. Cir. 1983), *cert. den.*, 469 U.S. 851 (1984).

Claims 10-14, as amended, and new claims 15-27 claim a combination of an electronic device and an electromagnetic interference suppressing device, and a method for suppressing magnetic waves in such devices. Goto is clearly directed to a magnetic recording medium, and so the medium must be in motion relative to



0694-121

Ser. No. 09/074,012

some electronic and/or magnetic device that generates magnetic waves. The claims of the present invention recite a static combination of the composite magnetic body and the electronic device, in which no movement is required.

In accordance with the above discussions, it should be clear that neither Goto et al., nor the rest of the prior art of record, taken alone or in combination, disclose or suggest the claimed invention. Additionally it should be clear that the Examiner has not established a prima facie case of obviousness and has used hindsight in the attempt. Hindsight cannot be used to establish a prima facie case of obviousness. *In re Fritch*, 23 USPQ2d 1780 (CAFC 1992).

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims. Reconsideration and allowance of the claims is respectfully solicited.

Respectfully submitted,

Alfred Basichas
Reg. No. 38,771

CERTIFICATE OF MAILING OR TRANSMISSION – 37 CFR 1.8

I hereby certify that I have a reasonable basis that this paper, along with any referred to above, (i) are being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to Commissioner of Patents and Trademarks, Washington, D.C. 20231, or (ii) are being transmitted to the U.S. Patent & Trademark Office in accordance with 37 CFR § 1.6(d).

DATE: February 28, 2001NAME: Hamida Jaffer

SIGNATURE:

Hopgood, Calimafde,
Judlowe & Mondolino LLP
60 East 42nd Street
New York, New York 10165
212-551-5000 ext.4081
Fax 212-949-2795

Dated: February 28, 2001

TC 1700 MAIL ROOM

MAR 12 2001

RECEIVED